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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,783	03/29/2001	Mark A. Harper	10003236-1	6395

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HEWLET-PACKARD COMPANY  
Intellectual Property Administration  
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Fort Collins, CO 80527-2400

EXAMINER

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# **Office Action Summary**

Application No.

09/823,783

Applicant(s)

HARPER, MARK A.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## **Status**

- 1) ☒ Responsive to communication(s) filed on 11/8/2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## **Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## **Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## **Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to the Applicant's amendment filed on November 8, 2004. Claims 1-20 are pending and will be considered for examination.

### ***Final Rejection***

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites the limitations "...to order consumables via the computer peripheral device..." (lines 9 and 10) and "...forward the customer preferences to the computer peripheral device using a messaging address for the computer peripheral device" (lines 14-16). The Applicant's specification does not enable these limitations because there is no hardware element present in the peripheral device (e.g. a network interface card) that would allow the peripheral device to communicate directly with the reseller and manufacturer web servers. The Applicant discloses in Figure 1 that the

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computer peripheral device is connected to a personal computer via bus "18".

However, this bus provides communication between the peripheral device and the personal computer only. There is no direct connection between the peripheral device and the reseller/manufacture web servers. The Applicant's specification also teaches that bus "18" is a network connection that connects multiple devices within a common network or an enterprise network connection within an interconnected network (page 6, lines 1-5). However, this describes nothing more than an I/O bus that does not inherently have Internet capability. Moreover, bus "18" is incapable of allowing the peripheral device to communicate directly with the reseller/manufacture web servers since these web servers are outside the common network or enterprise network. The peripheral device would require a direct Internet connection as show in Figure 1 items "22" and "24". Likewise claim 3 recites the limitation "...communication link interconnecting the personal computer, the reseller web server, the device manufacturer web server, and the computer peripheral device." The specification teaches that the "communication link" is an Internet connection (page 5, lines 7-10; Figure 1). However, as already noted above, in order to be Internet enabled a device must have a network interface card that has been configured to handle Internet connectivity. This is inherent in the personal computer (Figure 1, item "14") since the specification shows an Internet connection (Figure 1, items "22" and "24"), but it is not inherent in the peripheral device (Figure 1, item "16") because the only means of communication for the peripheral device is bus "18". Finally, claim 18 recites "...device manufacture web server...forwards a message...to the embedded web server of the computer peripheral

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device..." A similar analysis applies to this limitation. For these reasons, claims 1-11 and 18 are not enabled.

Claims 1-3, 7, and 9-20 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A step or element that is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The Applicant's specification teaches that an embedded web server in the peripheral device is critical or essential to the practice of the invention. In particular, the Applicant's specification teaches that the limitation "...order consumables via the computer peripheral device..." requires an embedded web server in the peripheral device (see paragraphs [0029]-[0033]). For this reason, claims 1-3, 7, and 9-20 are not enabled.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As noted above in the 112, first paragraph rejection, claims 1, 3, and 18 are not enabling. Therefore it is unclear to the Examiner how the reseller and the manufacturer web servers are able to communicate directly with the peripheral device. For examination purposes, the Examiner will assume that all communication and ordering occurs via the personal computer since the personal

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computer is the only device that is capable of communicating directly with the peripheral device and the reseller/manufacturer web servers.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-4, 8-10, 12, 13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Istvan (US 2002/0042747 A1) in view of Yoda (US Patent 5,515,268).**

Referring to claims 1-3, 12, 13, and 19, Istvan teaches a personal computer having web browser and a messaging system (page 1, paragraphs [0008], [0010], [0028], and Figure 1, item "102"); a computer peripheral device having a messaging system communicating with the personal computer (page 1, paragraph [0006]; page 2, paragraph [0034]; Figure 12; page 5, paragraph [0073]). Istvan does not teach a reseller web server having a messaging system communicating with the personal computer configured to capture customer preferences from a customer accessing the reseller web server to order consumables via the computer peripheral device. However, Istvan teaches that a user may order ink refill product via the communication device by shopping on-line (page 1, paragraph [0008]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have the on-line merchant in the invention of Istvan be a reseller. One of ordinary skill in the art would have been motivated to do so in order to have the user visit a website that had the item

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the user was interested in buying. Istvan does not teach that the on-line merchant captures customer preferences. However, Yoda teaches an apparatus for computer-assisted shopping wherein a remote vendor system (column 4, lines 23-28; Figure 1) captures a users personal preferences (column 5, lines 1-10). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Yoda into the apparatus of Istvan. One of ordinary skill in the art would have been motivated to do so in order to provide quicker and better service to customers, as taught by Yoda. Istvan and Yoda do not teach that a device manufacturer web server communicates with the reseller web server and receives customer preferences from the reseller web server. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to do so. One of ordinary skill in the art would have been motivated to do so in order to allow the reseller and the manufacturer to have business-to-business (B2B) relationship.

Referring to claims 4, 8, and 9, Istvan teaches that the computer peripheral device forwards the customer preferences to the personal computer via the messaging system (page 1, paragraph [0006]; page 5, paragraphs [0074]-[0080]). Istvan does not teach that the preferences are sent to the web browser of the personal computer. However, Istvan teaches that the personal computer has a web browser (page 1, paragraph [0008]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to deliver the information to the web browser of the personal computer. One of ordinary skill in the art would have been motivated to do so in order to provide a user with data using a well-known, user-friendly, graphical

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interface. Istvan does not teach that the computer peripheral device comprises an embedded web browser. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate an embedded web sever in the peripheral device of Istvan. Applicant has not disclosed that the embedded web server in the peripheral devices provides an advantage, is used for a particular purpose or solves a stated problem. Furthermore, one of ordinary skill in the art would have expected Applicants' invention to perform equally well with the communication system disclosed by Istvan because the peripheral device is only communicating the personal computer. Therefore, it would have been obvious to one of ordinary skill in this art to modify the prior art to obtain the invention as specified in the claims.

Referring to claim 10, Istvan and Yoda do not teach that the customer preferences include consumable order information. However, the Examiner notes that this limitation is not functionally involved in the elements of the recited apparatus. Therefore this limitation is deemed to be nonfunctional descriptive material. The structural elements of the apparatus would be the same regardless of what information the customer preferences contained. The differences between the content of the Applicant's preferences and the prior art preferences are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the



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preferences of Istvan because such information does not functionally or structurally relate to the elements of the claimed apparatus and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Istvan (US 2002/0042747 A1) in view of Yoda (US Patent 5,515,268) and further in view of Hartman et al. (US Patent 5,960,411).

Referring to claims 5 and 11, Istvan and Yoda do not teach that the web browser generates a consumable order message incorporating the customer preferences and forwards the consumable order message and customer preferences to a reseller to order a consumable that matches the customer preference or that the web server captures customer profile data. However, Hartman teaches an apparatus for on-line ordering wherein a web browser generates a consumable order message incorporating the customer preferences and forwards the consumable order message and customer preferences to an on-liner merchant to order a consumable that matches the customer preference (Figure 1C, column 5, lines 56 – column 6, line 21) and further captures customer profile data (column 5, lines 9-26). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Hartman into the apparatus of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to help facilitate repeat orders.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Istvan (US 2002/0042747 A1) in view of Yoda (US Patent 5,515,268) and further in view of Official Notice.

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The cited prior art does not teach that a web page is provided on the device manufacturer web server and communicating with the personal computer and the reseller web server, and operative to provide a link to the reseller web server. However, Official Notice is taken that it is old and well known in the art to for a web page, residing on a web server communicating with a plurality of entities, to include a link to another entity. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the invention of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide user with the convenience of easily moving around on the World Wide Web.

**Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Istvan (US 2002/0042747 A1) in view of Yoda (US Patent 5,515,268) and further in view of Hartman et al. (US Patent 5,960,411) and Kageyama (US Patent 6,333,790 B1).**

Istvan teaches that the computer peripheral device detects a need to replenish a consumable and forwards a notification to the personal computer indicating the need to replenish the consumable (Page 1, paragraphs [0005] and [0006]; page 5, paragraphs [0074]-[0077]). The cited prior art does not teach automatically generating a consumable order message in response notification to replenish the consumable. However, Kageyama teaches this limitation (column 11, lines 10-45). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Kageyama into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to automate the transaction.

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**Claims 14-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Istvan (US 2002/0042747 A1) in view of Yoda (US Patent 5,515,268) and further in view of Kageyama (US Patent 6,333,790 B1) and Official Notice.**

Istvan and Yoda do not teach submitting ordering information and the messaging address from the personal computer to a device manufacturer server indicating that a consumable needs to be ordered for the computer peripheral device at the messaging address. However, Kageyama teaches this limitation (column 11, lines 10-45; Figure 1, item "1002"). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Kageyama into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to automate the transaction. The cited prior art does not teach that the manufacturer server is a web server or forwarding the ordering information and the messaging address to a reseller web page. However, Official Notice is taken that it is old and well known in the art to configure a server as a web server. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate a web server into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to handle and process web-based interactions and transactions. Furthermore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to forward the order information and the messaging address to a reseller web page. One of ordinary skill in the art would have been motivated to do so in order to have the user visit a website that had the item the

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user was interested in buying. The cited prior art also does not teach that the device manufacturer web server includes a reseller selection page. However, Official Notice is taken that it is old and well known in the art to for a web page, residing on a web server communicating with a plurality of entities, to include a link or any other data. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the invention of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide user with the convenience of easily moving around on the World Wide Web. Finally, Official Notice is taken that the use of a shopping cart and data stream is also old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to support real-time, on-line transactions.

### ***Response to Arguments***

The Applicant's remarks and amendments filed November 8, 2004 are sufficient to overcome the objection to claims 4, 8, 9, 17, and 18. The objections are hereby withdrawn.

The Applicant's arguments filed November 8, 2004, with respect to the rejection of claims 1-11 and 18 under 35 U.S.C. §112, first and second paragraphs, have been fully considered but they are not persuasive. The Applicant has argued that an embedded web server within the peripheral device provides enablement for the rejected

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claims (see pages 7 and 8 of Remarks). However, the Examiner notes that this limitation does not appear in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). For this reason, the Examiner maintains the rejections under 35 U.S.C. 112, first and second paragraphs.

The Applicant's arguments filed November 8, 2004, with respect to the rejection of claims 1-20 under 35 U.S.C. §103, have been fully considered but they are not persuasive. The Applicant has argued that there is no motivation to combine Istvan with Yoda. The Examiner respectfully disagrees. Both Istvan and Yoda are directed to the field of online shopping. For this reason, the Examiner maintains the art rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

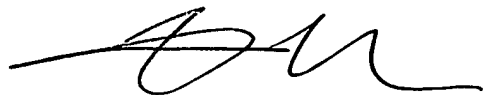
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (571)-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Naeem Haq**, Patent Examiner  
Art Unit 3625

July 5, 2005



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